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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,582	03/23/2004	Anne Mae Gaffney	A01253A	2222

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EXAMINER

ZUCKER, PAUL A

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,582

Applicant(s)

GAFFNEY ET AL.

Examiner

Paul A. Zucker

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-31 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 27-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 20 is/are rejected.
- 7) ☒ Claim(s) 22-26 is/are objected to.
- 8) ☒ Claim(s) 20-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>20050811</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/23/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

HC

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 20 and 22-26, drawn to a process for producing an unsaturated carboxylic acid, classified in class 562, subclass 549.
- II. Claims 21 and 27-31, drawn to a method for producing an unsaturated nitrile, classified, for example, in class 558, subclass 320.

The inventions are distinct, each from the other because of the following reasons:

There is no patentable co-action between the process since different starting materials are employed and different products are obtained.

Because these inventions are distinct for the reasons given above and the search required for Group I is not co-extensive with that required for Group II, restriction for examination purposes as indicated is proper.

1. During a telephone conversation with Marcella Bodner on 10 August 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 20 and 22-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21 and 27-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

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2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
3. The disclosure is objected to because of the following informalities: Applicants should amend the specification to include a reference to the parent application including its current status. The Examiner notes that Applicants have indicated (Remarks) that such amendment has been made but there is evidence that such an amendment has been made. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Ueda et al (Applied Catalysis A:General, 2000, pages 135-143). Ueda discloses (Page 142, top, Table 3, entry 2) the oxidation of propane using a catalyst of formula $\text{Mo}_6\text{V}_3\text{Te}_1\text{O}_x$ which corresponds to a catalyst as instantly required wherein $d = 0$; $M = \text{Te}$ and $c = 1$. Ueda therefore anticipates claim 20.

Claim Objections

5. Claims 22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

6. Claims 22-26 are drawn to allowable subject matter. The following is a statement of reasons for the indication of allowable subject matter: Ueda et al (Applied Catalysis A:General, 2000, pages 135-143), the closest prior art, neither discloses nor fairly suggests the instantly claimed process in the presence of catalyst prepared by the method of claim 22. Because the activity of these types of catalysts is highly dependent, in an unpredictable way, on their method of preparation one of ordinary skill in the art could not have reasonably expected to be successful in modifying Ueda's method of catalyst preparation to produce the instantly claimed process.

Conclusion


7. Claims 20-31 are pending. Claim 20 is rejected. Claims 22-26 are objected to. Claims 21 and 27-31 are withdrawn from further consideration as being drawn to a non-elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PAULA A. ZUCKER, PH.D.
PRIMARY EXAMINER